



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REQUEST FOR AN ORAL HEARING

APPELLANTS: Clasbrummel et al. CONFIRMATION NO. 4762
SERIAL NO.: 10.036,618 GROUP ART UNIT: 2125
FILED: December 21, 2001 EXAMINER: Carlos R Rodriguez Ortiz
TITLE: "METHOD AND APPARATUS FOR PREPARING AN
ANATOMICAL IMPLANT"

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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In accordance with the provisions of 37 C.F.R. §1.94, Appellants herewith request an oral hearing for in connection with the appeal of the above-referenced application. A check for the fee required under 37 C.F.R. § 1.17(d) in the amount of \$290.00 is submitted herewith.

Submitted by,

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(Reg. 28,982)

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CERTIFICATE OF MAILING

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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APPLICANT'S REPLY BRIEF

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In accordance with the provisions of 37 C.F.R. §1.193, Appellants herewith submit a Reply Brief in response to the Examiner's Answer dated June 3, 2004.

Appellants in the present Reply Brief will respond to the section in the Examiner's Answer beginning at page 9 entitled *Response to Argument*.

At page 9 in this section of the Examiner's Answer, the Examiner stated that it should be noted that the reference relied upon for the "intra-operatively" feature is the Kienzle, III et al. reference, and not the White reference. This statement in the Examiner's Answer, however, flatly contradicts the statement made by the Examiner at page 2 of the final rejection, wherein the Examiner stated "Regarding claim 1, White discloses a method for preparing an anatomical implant (see column 2, lines 13-14 and column 1, lines 7-9), comprising the steps of: in a medical intervention procedure, intra-operatively generating a three-dimensional dataset (see column 1,

lines 10-12) of body tissue (see column 1, lines 46-50 also see column 24, lines 44-46) of a subject...". In the final rejection, not only did the Examiner rely on the White reference as providing an "intra-operatively" teaching, but relied on a specific column and line citation.

Nevertheless, if the Examiner has now switched to relying on the Kienzle, III et al. reference for providing this teaching, Applicants respectfully submit that it is incorrect to simply pick out one word in a claim, and rely on a reference as providing a teaching for that word completely divorced from its context in the claim language. At page 10 of the Examiner's Answer, the Examiner characterized Applicants' arguments as being "against the references individually," and stated that one cannot show a non-obviousness by attacking references individually where the rejections are based on combinations of references. Appellants of course agree with this general statement of the law, but a corollary is that it is incorrect for an Examiner to analyze a patent claim one word at a time, as the Examiner apparently has done with regard to "intra-operatively." Moreover, in discussing a combination of references, it is unavoidable to begin with a discussion of the individual teachings of the references. In fact the Examiner's switch from reliance on the White reference to reliance on the Kienzle, III et al. reference as providing an "intra-operatively" teachings demonstrates the importance of first being sure what the individual references teach themselves, before proceeding onto proposing a combination of those teachings.

In the context of the Kienzle, III et al. and White references, as extensively discussed in Appellants Main Brief, it is completely irrelevant whether one of those

references, such as the Kienzle, III et al. reference, is capable of “intra-operatively” obtaining data, without being specific as to the type of data that are being obtained. Appellants have never denied that the Kienzle, III et al. reference is an example of many known C-arm devices that are capable of intra-operatively obtaining *two-dimensional* data. Such a teaching, however, is irrelevant to the language of independent claims 1 and 4, because each of those claims requires the intraoperative generation of a *three-dimensional* dataset of body tissue of a subject. The White reference is capable of generating *three-dimensional* data of a subject, but not intra-operatively. The Kienzle, III et al. reference is capable of generating intraoperative data, but not intraoperative three-dimensional data. Given the complete incompatibility of these two structures, it is not even possible to physically combine their teachings conceptually. The White reference is directed to a standard examination-type apparatus having a tunnel or opening that completely surrounds subject, as shown in Figure 5A (CT embodiment) and Figure 5B (MRI embodiment) in White. This is because the White reference provides no suggestion whatsoever that any steps undertaken with these different embodiments should, or can be, done intra-operatively. The Kienzle, III et al. reference is a C-arm device that is incapable of producing three-dimensional data. There is no reason why a person of ordinary skill in the field of implant design would even consider combining the concepts respectively disclosed in those references. This is the ultimate “combination” argument, and although it is unavoidably based on the teachings of the individual references, it is not for that reason deficient.

For the above reasons, Appellants respectfully request reversal of the rejection.

Submitted by,

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